

REMARKSRequest for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the claims, the attached Declaration of Mr. Hiroshi Yamazaki and the following remarks.

Claims Status

Claims 1-11 are pending. Claims 2-5 had been withdrawn from consideration while Claims 1 and 6-9 had previously been examined. Claims 10 and 11 are newly added. Claims 10 and 11 find support in the Specification in the paragraph bridging pages 12 and 13.

Claim Rejection

Claims 1 and 6-8 had been rejected as being anticipated by Nozawa or unpatentable over a combination of Nozawa and Rimai. Claim 9 had been rejected as being unpatentable over a combination of Nozawa and Yachi. Applicants respectfully traverse these rejections.

Nozawa

In the Office Action, the Examiner takes the position that Nozawa inherently contains the limitation of that diameter of the particles measured by a flow particle image analysis of from not less than 0.60 to less than 1.00 microns is not more than 5% in number. The Examiner based this inherency argument on Example 70 in Nozawa. Applicants have tested Example 70 in Nozawa and have determined that Example 70 in Nozawa contains 5.8% of particles having a diameter in the range of 0.60 to 1.00 microns, see the Table between paragraphs 5 and 6 of the attached Declaration of Mr. Yamazaki. Thus, Applicants have clearly demonstrates that Example 70 of Nozawa falls outside the range of Claim 1.

Applicants wish to remind the Examiner that Example 34 of Nozawa was also tested and that Example 34 of Nozawa also fell outside the claimed range for the percent of particles that had a diameter in the range of 0.60 to 1 micron. Respectfully, Applicants have demonstrates now that Nozawa does not inherently meet the claimed particle size limitation as recited in Claim 1 of the Application.

NOZAWA and RIMAI

The Examiner has taken the position that it would be obvious to one of skill in the art to combine the teachings of Nozawa and Rimai. Applicants respectfully traverse this combination and specifically traverse the combination of Rimai with Examples 34 and 70 to arrive at the present Invention.

First, it will be noted that Nozawa teaches that SF-1/SF-2 is generally in the range of 1 to 1.2, see Column 14, line 7, because SF-1 is 100 to 170 and SF-2 is 100-140, $100/100 = 1$ AND $170/140 = 1.2$.

The Examiner noted, however, that there are at least two examples that teach this ratio of SF-1 to SF-2 within the claims, namely, Examples 34 and 70. For both of these, the SF-1 is on the order of 160. SF-1 is essentially a measurement of the circularity or roundness of particles. In other words, the closer SF-1 is to the value 100, the rounder the particle is. Thus, for SF-1 of 160, the particle is not round or spherical in nature but, rather, an oval.

In Rimai, Rimai is teaching that his particles should be generally spherical in nature, see Column 3, lines 18-20 wherein it states that "it is preferred that the toner particles be substantially spherical in configuration". This means that such toner particles should have an SF-1 value in the neighborhood of 100.

Applicants submit that since Rimai is teaching that its toner particles should have an SF-1 value in the neighborhood of 100, it is inappropriate for one of skill in the art to take the toner of Rimai and combine it with a toner of Nozawa where the toner of Nozawa has an SF-1 value as high as 160.

It may be appropriate to combine Rimai with Nozawa with an SF-1 value in the neighborhood of 100. Respectfully, however, no one of skill in the art would take the spherical particles of Rimai and use them with the non-spherical particles in Nozawa, the non-spherical particles being particles having an SF-1 value on the order of 160.

However, even if Rimai were combined with Nozawa, a combination would not yield a toner having an SF-1 value in the neighborhood of 125 to 170. The reason for this is because Rimai teaches his particles should be spherical, thus, Rimai is

teaching that his particles have an SF-1 value in the neighborhood of 100. Thus, any combination of Rimai and Nozawa would result in a toner particle that falls outside of the claimed SF-1 value of the present Invention because such a particle would have an SF-1 value around 100. Thus, it is submitted that, if Nozawa and Rimai were properly combined, the SF-1 value of this particle would clearly fall in the neighborhood of 100 and not as high as 125.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: 

Timothy D. Meade, Reg. #55,449
Attorney for Applicant(s)
475 Park Avenue South, 15th Floor
New York, NY 10016
Tel. # 212-661-8000

Encl: Executed Declaration of Mr. Hiroshi Yamazaki